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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/754,800

01/09/2004

Robert Henry Roche

1600

7590

07/13/2005

Robert H. Roche
Suite H
1004 Littlestown Pike
Westminster, MD 21157-3026

EXAMINER

STONE, JENNIFER A

ART UNIT

PAPER NUMBER

2636

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/754,800

Applicant(s)

ROCHE ET AL.

Examiner

Jennifer A. Stone

Art Unit

2636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Appendix.

Specification

1. The abstract of the disclosure is objected to because the term aggress, which means an act of aggression, should be changed to egress, which means to go or come out, exit. Correction is required. See MPEP § 608.01(b).
2. The disclosure is objected to because of the following informalities: the term aggress, which means an act of aggression, should be changed to egress, which means to go or come out, exit.

Appropriate correction is required.

Information Disclosure Statement

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

4. Claim 6 is objected to because of the following informalities: the term aggress, which means an act of aggression, should be changed to egress, which means to go or come out, exit. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-7 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph (see claim rejections below).

The claims are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

7. Claim 2 recites the limitation "the whole of the protected dome-type volumetric room" in line 1.
8. Claim 3 recites the limitation "the geometrical shapes and dimensions of said 2-D curvilinear or 3-D curved surface areas" in lines 1 and 2.
9. Claim 3 recites the limitation "the spatio-temporal parameters" in lines 2 and 3.
10. Claim 5 recites the limitation "the appropriate technique" in line 1.
11. Claim 6 recites the limitation "the aim" in line 3.
12. Claim 6 recites the limitation "the principle" in line 5.
13. Claim 7 recites the limitation "the mutual set of instruments" in line 3.
14. Claim 7 recites the limitation "the appropriate software" in line 3.

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15. Claim 7 recites the limitation "the defense-in-depth intrusion detection signal processing" in line 4.

16. Claim 1 recites the limitation "the aim" in line 2.

17. Claim 1 recites the limitation "the purposeful interrelation" in lines 1 and 2.

18. Claim 6 recites the limitation "the generalized graphic-analytical model" in line 1.

There is insufficient antecedent basis for these limitations in the claims.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Mehnert (US 4,319,332)

For claim 1, Mehnert discloses a method of defense-in-depth ultrasound intrusion detection that establishes the purposeful interrelation of various techniques of ultrasound intrusion detection with the aim to ensure an early and anticipatory defense-in-depth intrusion protection throughout a multi-echelon and dome-shaped volumetric space around a surveyed critical installation (Fig. 1, items 19-21; col 3, lns 38-41 and 48-52; col 4, lns 63-68).

For claim 2, the whole of the protected dome-type volumetric room around a critical installation is being arranged in several juxtaposed areas, which areas are being

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defined as interrelated echelons of an entire defense-in-depth intrusion detection space (Fig. 1; col 5, lns 41-48; col 10, lns 40-42).

For claim 3, the geometrical shapes and dimensions of said 2-D curvilinear or 3-D curved surface areas are being put in correspondence to the spatio-temporal parameters of air-borne ultrasound propagation, the presumptive spatio-temporal behavior of an intruder or trespasser (col 7, lns 8-17 and 63-68; col 8, lns 1-4), as far as to the available capabilities of covering all the said surfaces with the appropriate stationary or scanning ultrasound beam patterns during surveillance (col 5, lns 41-48 and 56, 57; Fig. 2 depicts a 3-D curved geometric surface area).

For claim 4, Mehnert discloses a proper graphic-analytical model of intrusion vulnerability for each echelon is being composed with regard to the options of supposed spatio-temporal purposeful behavior of intruder or trespasser, which graphic analytical model is being used for verifying geometrical shape and dimensions of every echelon of said entire defense-in-depth intrusion detection space (col 7, lns 63-68; col 8, lns 1-4 and 15-29; Fig. 2).

For claim 5, the appropriate technique of ultrasound intrusion detection for each of said echelons is being chosen and assigned regarding the type of ultrasonic beam responding, i.e. reflection, refraction, and interference, which types of ultrasonic beam responding are being respectively selected in compliance with previously composed graphic-analytical models of intrusion vulnerability for each surveyed echelon (col 5, lns 16-28; col 7, lns 63-68; col 8, lns 1-4).

For claim 6, Mehnert discloses the generalized graphic-analytical model of intrusion vulnerability for entire protected dome-type volumetric room around a critical installation is being composed, which model is being created with the aim to establish an operatively reliable and functionally correct signal-processing interrelation amongst different adjacent echelons based on the principle of early and anticipatory ultrasound detection of ingress or aggress intrusion thereinto (col 8, lns 21-29; col 21, lns 57-61).

For claim 7, the diversity of hardware and software of all techniques of ultrasound intrusion detection involved is being minimized with the aim of consequent assembling the mutual set of instruments and prepare the appropriate software for logically exhaustive the defense-in-depth intrusion detection signal processing (col 2, lns 59-64; col 15, lns 38-45; Fig. 6).

Conclusion

21. An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Attorney and Agent

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Roster." Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U. S. Patent and Trademark Office, PO Box 1450, Alexandria, VA 22313-1450

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gal et al. (US 6,411,202) discloses an ultrasonic transmitter that measure geometry of objects and an interior space for object detection.

Bonge, Jr. (US 5,872,516) discloses a dome-shaped ultrasonic detection area that comprises multiple juxtaposed echelons to detect intrusion into a protected area.

Cleveland et al. (US 2004/0140886) discloses an ultrasonic multi-echelon transmitter that detects objects within a protected area.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A Stone whose telephone number is (571) 272.2976. The examiner can normally be reached on M-F from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Hofsass, can be reached at (571) 272.2981. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should


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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Stone
July 8, 2005



JEFFERY HOFSSASS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Appendix

1. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form may be required. While an application can be amended to make it clearly understandable, no subject matter (new matter) can be added that was not disclosed in the application as originally filed.

2. Following are the copies of § 37 CFR 1.71 (Detailed description and specification of the invention), § 37 CFR 1.75 (Claims), § 37 CFR 1.111 (Reply by applicant or patent owner to a non-final Office action), § 37 CFR 1.112 (Reconsideration before final action), § 37 CFR 1.113 (Final rejection or action), § 37 CFR 1.121 (Manners of Making Amendments in applications), § 37 CFR 1.125 (Substitute specification), and § 37 CFR 1.126 (Numbering of Claims) are provided below regarding the proper format and contents of an application and its amendments:

§ 1.71 Detailed description and specification of the invention.

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to

such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

(d) A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, “©1983 John Doe”(17 U.S.C. 401) and “*M* John Doe” (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the authorization language set forth in paragraph (e) of this section is included at the beginning (preferably as the first paragraph) of the specification.

(e) The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any- one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever.

[paras. (d) and (e), 53 FR 47808, Nov. 28, 1988, effective Jan. 1, 1989; para. (d), 58 FR 38719, July 20, 1993, effective Oct. 1, 1993]

§ 1.75 Claim(s)

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. Any dependent claim which refers to more than one other claim (“multiple dependent claim”) shall refer to such other claims

in the alternative only. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. For fee calculation purposes under § 1.16, a multiple dependent claim will be considered to be that number of claims to which direct reference is made therein. For fee calculation purposes, also, any claim depending from a multiple dependent claim will be considered to be that number of claims to which direct reference is made in that multiple dependent claim. In addition to the other filing fees, any original application which is filed with, or is amended to include, multiple dependent claims must have paid therein the fee set forth in § 1.16(d). Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of each of the particular claims in relation to which it is being considered.

(d)(1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See § 1.58(a)).

(2) See §§ 1.141 to 1.146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) A preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known,

(2) A phrase such as “wherein the improvement comprises,” and

(3) Those elements, steps, and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

(f) If there are several claims, they shall be numbered consecutively in Arabic numerals.

(g) The least restrictive claim should be presented as claim number 1, and all dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

(h) The claim or claims must commence on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

[31 FR 12922, Oct. 4, 1966; 36 FR 12690, July 3, 1971; 37 FR 21995, Oct. 18, 1972; 43 FR 4015, Jan. 31, 1978; para. (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (g) amended, paras. (h) and (i) added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

§ 1.111 Reply by applicant or patent owner to a non-final Office action.

(a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) A second (or subsequent) supplemental reply will be entered unless disapproved by the Commissioner. A second (or subsequent) supplemental reply may be disapproved if the second (or subsequent) supplemental reply unduly interferes with an Office action being prepared in response to the previous reply. Factors that will be considered in disapproving a second (or subsequent) supplemental reply include:

(i) The state of preparation of an Office action responsive to the previous reply as of the date of receipt (§ 1.6) of the second (or subsequent) supplemental reply by the Office; and

(ii) The nature of any changes to the specification or claims that would result from entry of the second (or subsequent) supplemental reply.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable

subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

[46 FR 29182, May 29, 1981; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.112 Reconsideration before final action.

After reply by applicant or patent owner (§ 1.111 or § 1.945) to a non-final action and any comments by an inter partes reexamination requester (§ 1.947), the application or the patent under reexamination will be reconsidered and again examined. The applicant, or in the case of a reexamination proceeding the patent owner and any third party requester, will be notified if claims are rejected, objections or requirements made, or decisions favorable to patentability are made, in the same manner as after the first examination (§ 1.104). Applicant or patent owner may reply to such Office action in the same manner provided in § 1.111 or § 1.945, with or without amendment, unless such Office action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an inter partes reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001]

§ 1.121 Manner of making amendments in application.

Revised (see attachment)

§ 1.125 Substitute specification.

(a) If the number or nature of the amendments or the legibility of the application papers renders it difficult to consider the application, or to arrange the papers for printing or copying, the Office may require the entire specification, including the claims, or any part thereof, be rewritten.

(b) A substitute specification, excluding the claims, may be filed at any point up to

payment of the issue fee if it is accompanied by:

- (1) A statement that the substitute specification includes no new matter; and
 - (2) A marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the specification of record. Numbering the paragraphs of the specification of record is not considered a change that must be shown pursuant to this paragraph.
- (c) A substitute specification submitted under this section must be submitted in clean form without markings as to amended material. The paragraphs of any substitute specification, other than the claims, should be individually numbered in Arabic numerals so that any amendment to the specification may be made by replacement paragraph in accordance with § 1.121(b)(1).
- (d) A substitute specification under this section is not permitted in a reissue application or in a reexamination proceeding.

[48 FR 2712, Jan. 20, 1983, effective Feb. 27, 1983; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (b)(2) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

§ 1.126 Numbering of claims.

The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled the remaining claims must not be renumbered. When claims are added, they must be numbered by the applicant consecutively beginning with the

number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

[32 FR 13583, Sept. 28, 1967; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

3. It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office action.
5. Title of invention.

4. It has called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. A suggested format for a certificate follows.

"I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 2023 1, on..."

Name of applicant, assignee, or Registered Representative

Signature _____

Date _____

5. The applicant is reminded that copies of U.S. patents have been provided with this Office Action as examples for proper application format.

Attachment

Revised Amendment Practice 37 CFR 1.121

Strict compliance is mandatory - all amendments filed on or after July 30, 2003 must comply with the revised 37 CFR 1.121, except amendments to the specification and claims filed in reissue applications and reexamination proceedings.

A sample amendment document and Q's and A's are posted on the USPTO's website at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/moreinfoamdtprac.htm>

Major Changes from Notice of Proposed Rule Making :

Only seven status identifiers are permissible instead of eleven.

The text of withdrawn claims must be included in the listing of the claims.

Comments on the NPR suggested supplying text of withdrawn claims for rejoinder purposes.

Applicants may need to amend withdrawn claims to include limitations added to elected claims to permit rejoinder.

Drawing changes may be shown by annotated drawings.

Permissible markings only include underlining, strikethrough, and double brackets [[]].

Note: changes from NPR are highlighted in bold on the next few slides.

Highlights:

1. Each section of an amendment paper must start on a separate sheet.

For example: each of the following sections must start on a separate sheet:
Introductory comments, Amendments to the Specification, Amendments to the Claims, Amendments to Drawings, and Remarks.

2. Submit only one version of the replacement paragraph or section, or currently amended claims, with markings (i.e., strikethrough, **double brackets** [[]], or underlining), to show the changes relative to immediate prior version.

The requirement to provide a separate, clean version has been eliminated, except when applicant submits a substitute specification.

3. When there is any amendment to a claim, a claim listing of all claims ever presented in the case must be supplied in ascending numerical order.

An example of a claim listing is as follows:

Claims 1-5 (canceled)

Claim 6 (previously presented) A bucket with a handle.

Claim 7 (withdrawn) A handle comprising an elongated wire.

Claim 8 (withdrawn) The handle of claim 7[[6]] further comprising a plastic grip.

Claim 9 (currently amended) A bucket with a green blue handle.

Claim 10 (original) The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new) A bucket with plastic sides and bottom.

Amendments to Claims

What is a claim listing?

A claim listing must include:

The claim number of every claim ever presented in the application, whether entered or not;

A status identifier, in parentheses, following each claim number;

The text of all pending claims (including withdrawn claims); and

Markings to show the changes made only in the current amendment relative to immediate prior version.

The claims in the listing (in the current amendment) will replace all prior versions, and listings, of claims in the application.

The seven (7) permissible status identifiers and their definitions, are:

1. **(Original)**: Claim filed with original specification (not added by preliminary amendment and not previously amended).
2. **(Currently amended)**: Claim being amended in the current amendment. Currently amended claims must include markings (strikethrough, double brackets, or underlining) to indicate changes.
3. **(Canceled)**: Claim canceled or deleted in current amendment or previously. Do not present the text of a canceled claim. Consecutive canceled claims may be grouped together (e.g., claims 1-5 (canceled)).
4. **(Withdrawn)**: Non-elected claim.

The text of a withdrawn claim must be presented.

Withdrawn claims that are being currently amended must be presented with markings (strikethrough, double brackets, or underlining) to indicate changes.

Example: Claim 8 (withdrawn) The handle of claim 7[[6]] further comprising a plastic grip.

5. **(Previously presented)**: This is a generic identifier to cover any claim that was previously added or amended in an earlier amendment paper.

The proposed identifiers "previously amended" or "previously added" were not adopted, and must not be used.

6. **(New):** Claim being added in the current amendment paper. The text of the claim must be presented in clean form without underlining.
7. **(Not entered):** Claim presented in a previous unentered amendment.

Do not present the text of a not entered claim.

Consecutive not entered claims may be grouped together (e.g., Claims 20-25 (not entered)).

If in doubt as to whether a prior amendment was entered, the claim should be presumed to be "not entered".

The following status identifiers in NPR have been eliminated:

previously amended,
previously added,
reinstated-formerly claim #_,
previously reinstated,
re-presented-formerly dependent claim #_, and
previously re-presented.

Multiple status identifiers must not be used for any single claim.

Only claims of the status "currently amended" and "**withdrawn**" (if the withdrawn claims are being currently amended) may include markings.

All other pending claims (including **withdrawn** claims that are not being currently amended) must be presented in clean text (without markings):

Any claim presented in clean text (no markings) constitutes an assertion that it has not been changed relative to the immediate prior version, except omitting markings (*i.e.*, underlining, strikethrough, and double brackets) and deleted text.

For example,

If the immediate prior version of the claim was:

"Claim 1 (currently amended) A bucket with a ~~blue~~ handle."

The listing of claims in the current amendment must have:

"Claim 1 (previously presented) A bucket with a handle."

Canceled claims and **not entered** claims may only have a "canceled" or "not entered" status identifier after the claim number. The text must not be supplied.

Grouping of Claims - consecutive canceled claims or **not entered** claims may be aggregated into one line.

Examples:

Claims 1-5 (canceled)

Claims 20-25 (not entered)

New or added claims must have "new" as a status identifier

Do not underline the text of the new claims.

Markings to Show Changes:

The following must include markings to show all changes relative the immediate prior version:

Replacement paragraphs or sections,
Replacement abstracts,
Currently amended claims, and
Substitute specifications.

Added text must be shown by underlining.

Deleted text must be shown by **strikethrough** (e.g., ~~strikethrough~~) with 2 exceptions.

1. For deletion of five or fewer consecutive characters, **double brackets** **[[]]** may be used (e.g., **[[error]]**); and
2. If strikethrough cannot be easily perceived, deleted text must be shown by **double brackets** **[[]]** around the deleted text characters.

For example: changing "4 corners" to "three corners"
should be indicated by "three**[[4]]** corners".

For changes of punctuation marks or difficult to perceive characters, applicants may delete text before and after with strikethrough, and then insert such text along with the change by underlining. For example:

If the hyphen in "strike-through" is to be deleted, it may be shown as
"strike-through**[[]]**strikethrough"

Amendments to Specification

The location of the paragraph or section to be deleted or replaced, or where a new paragraph or section is to be added, must be unambiguously identified.

The location can be identified by using a few words at the beginning and/or the end of the paragraph or section.

Do not underline the text of a new paragraph or section.

Deletion of a paragraph or section must only include an instruction to delete, and the location of the paragraph or section.

Replacement paragraph or section must be a marked-up version showing the changes.

A clean version of any replacement paragraph or section must not be submitted in addition to a marked up version, except when applicant submits a substitute specification.

Amendments to Abstract

An amendment to an abstract is treated like an amendment to the specification.

If the changes are minor in nature, submit a replacement abstract with markings to show all changes relative to the immediate prior version.

If the abstract is being substantially rewritten, submit a new abstract in clean text (no markings) accompanied by an instruction for the cancellation of the previous abstract.

Any new, or replacement, abstract must be submitted on a separate sheet (37 CFR 1.72).

Substitute Specification

Substitute Specification under 37 CFR 1.125 requires:

A statement that the substitute specification includes no new matter.

A specification with markings to show all the changes relative to the immediate prior version.

A **clean version** (without markings) of the substitute specification.

The requirements of a marked-up version and a clean version have been retained.

Amendments to Drawings

Amendment to drawings must include:

Replacement drawing sheet showing amended figures which include the desired changes, without markings, on a separate sheet in compliance with §1.84; and

Explanation of the changes in the remarks, or preferably, in the drawing amendments section, of the amendment paper.

Optional unless required by examiner:

Annotated drawing sheet - a marked-up copy of the amended figure(s) with annotations showing the change(s) may be submitted, or required by the examiner.

Replacement drawing sheet(s) must be identified in top margin as "**Replacement Sheet**".

Annotated drawing sheet(s) must be identified in top margin as "**Annotated Marked-up Drawings**".

This will avoid confusion between a replacement sheet and an annotated sheet. Annotated drawing sheet(s) will not be entered as part of the official drawing(s) for the application.

The replacement drawing sheet(s) and annotated drawing sheet(s), if any, should follow the last page of the amendment paper, as attachment(s).

Proposed drawing correction process is eliminated.

Replacement drawing sheet with changes is accepted by examiner, unless otherwise notified by examiner. No further drawing submission is required.

If not acceptable, applicants will be notified of any objections or additional requirements.

Any replacement drawing sheet including amended figures must include all of the figures appearing on the immediate prior version of the sheet.

The replacement drawing figure must not be labeled as "amended."

37 CFR 1.173 now provides for amending drawings in reissue applications in a similar manner.

Deletion of a figure requires the following:

An instruction to delete the figure;

A replacement sheet which does not include the canceled figure, unless no other figure is on the same sheet as the canceled figure;

Amendment to the specification to make corresponding changes to the description of the drawings (e.g., deletion of the description of the canceled figure); and

If other figures need to be renumbered, those figures also need to be amended with revised figure numbers via replacement drawing sheets.

After Final Amendments

Any amendment after final (§1.116), or amendment filed with a request for continued examination (RCE) under §1.114, must include markings showing the changes relative to the last entered amendment.

Do not include markings to show changes relative to any unentered amendment.

Applicant should not assume that an after final amendment is entered because after final amendments are not entered as a matter of right (§1.116).

If applicant has not received an advisory action, applicant should check via PAIR, or call the examiner, to determine whether the after final amendment has been entered before filing another after final amendment or an amendment with an RCE.

If the advisory action has indicated that an after final amendment will be entered upon the filing of an appeal, applicant should assume that the after final amendment is not entered.

Any subsequent amendment must include markings showing the changes relative to the last entered amendment, and not the amendment which the advisory action indicated will be entered upon the filing of an appeal.

If applicant wishes to file an RCE after filing more than one after final amendment that has not been entered, applicant is encouraged to file an amendment with the RCE that includes:

Instructions not to enter the unentered after final amendments; and

All of the desired changes, including changes presented in the unentered after final amendments.

The markings must show changes relative to the last entered amendment.

A claim listing which includes any unentered claims presented using the status identifier "not entered" (e.g., claims 20-25 (not entered)).

Any new claims must be numbered consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not).

Treatment of Non-Compliant Amendments

Applicants will be notified of any amendment paper that is not accepted because the changes do not comply with revised §1.121.

For preliminary amendments and replies to non-final Office actions or notices,

A Notice of Non-Compliant Amendment identifying the problem section(s) will be mailed; and
A period for reply shall be given; but
Patent term adjustment (PTA) reductions may be incurred. See §1.704(c)(7).

For after-final amendments,

Non-compliance will be indicated in an advisory action; and
The time period for reply continues to run from the mailing date of the final Office action.
See MPEP 714.03 (8th Ed. 1st Rev., Feb. 2003).

The Notice of Non-Compliant Amendment will identify:

Each section of the amendment that is not in compliance with 37 CFR 1.121;
Items that are required for compliance; and
The reasons why the section of the amendment fails to comply with 37 CFR 1.121.

In reply to the Notice, applicants must submit the **corrected section of the amendment** that was non-compliant.

Re-submission of the entire amendment is not required.
The entire section, however, with corrections, must be resubmitted.

The Office will only enter the sections of the amendment that are in compliance with 37 CFR 1.121.

Example

Non-compliant claim amendment example:

If an amendment includes:
(1) amendments to the specification, and
(2) amendments to the claims, including adding new claims 21 - 25,

But the amendments to the claims were non-compliant,
Because the claim listing did not include a status identifier for each claim,
A Notice of Non-Compliant Amendment will be mailed.

In reply to the Notice, applicant must submit a **corrected claim listing** that includes a status identifier for each claim.

The new claims 21-25 must be presented with the status identifier of "new" and the text of the claims not underlined.

Note: the new claims 21-25 must not be presented with the status identifier of "not entered" and must not be renumbered as claims 26-30.

A non-compliant amendment is different than an unentered after final amendment situation.
In the after final situation, the claim numbers of any unentered new claims may not be re-used.

The Office would enter:

1. The amendments to the specification from the original amendment paper, and
2. The amendments to the claims that include the corrected claim listing from the paper filed in reply to the Notice.

International Applications

The revised amendment practice under 37 CFR 1.121 does not apply to amendments filed in the international stage of an international application.

Such amendments must be in compliance with the Patent Cooperation Treaty (PCT) amendment procedure (*i.e.*, PCT Articles 19 and 34(2)(b)).

Thus, status identifiers are not to be used during the international stage.

Amendments filed in the national stage (pursuant to 35 U.S.C. 371) of an international application must comply with the revised amendment practice under 37 CFR 1.121.

The status identifier "original" must only be used for claims that were presented on or before the international filing date and have not been modified or canceled.